

REMARKS

This Response to Office Action is in response to the office action mailed September 29, 2004, for the above captioned patent application. Claims 1-18 are pending in this application and have been rejected. No amendments to the claims are set forth herein.

The Examiner has rejected claims 1-3, 9-10 and 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent no. 3,971,367 ("Zaffaroni"). The applicant respectfully traverses the Examiner's rejection and asserts that the Examiner is misinterpreting the teachings of Zaffaroni. The applicant further respectfully asserts, contrary to the Examiner's position, that the limitations "for exercising the Kegel muscle of a female," "for insertion into the female's vaginal/anal cavity," and "such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity," must be afforded patentable weight in that each is not solely functional characteristics of the claimed device, but rather further define the structural shape, characteristics, and nature of the claimed invention.

More specifically, Zaffaroni teaches a device that is inserted entirely into the uterus in order to therapeutically deliver effective dosages of drugs. (See Abstract)(emphasis added). To achieve its objectives, Zaffaroni teaches that the device transforms in the uterus from a retentive form to a non-retentive form, during the drugs delivery, in order to be easily and unobtrusively removed or expelled from the uterus. (See Col. 5, line 64- col. 5, line 1). Further, the intrauterine drug delivery device, depicted in Fig. 6 of Zaffaroni, has a plurality of curves and again, is configured to be inserted entirely into the uterus.

On the other hand, the present application claims a generally S-shaped device that is not inserted entirely into the vaginal canal. More specifically, independent claim 1 claims that the S-shaped intermediate portion connecting the first rounded end to the second rounded end such that the ends and the intermediate portion lie in a plane and are spaced apart from each other such

that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity. This is not taught or even suggested by Zaffaroni. Again, Zaffaroni teaches a device that is inserted entirely into the uterus and it therefore does not teach that the rounded ends are spaced such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity. It is presumed that, in referring to Fig. 6 in Zaffaroni, the Examiner has identified the U-shaped curve near reference numeral 60 as the fulcrum, given the argument the Examiner set forth regarding claim 2. In that case, if the Zaffaroni "fulcrum" bears against the front wall and back wall of the Kegel muscle, as required by independent claim 1 of the present application, it would result in extreme discomfort to the user because the portion below the "fulcrum" would be inserted into the vaginal cavity.

Zaffaroni also fails to teach that a device that lies in a plane, as is required by independent claim 1 of the present application. Further, the applicant's claimed device and the device taught by Zaffaroni are used for entirely different purposes. The claimed device in the present application exercises the Kegel muscle and can be used for sexual stimulation, whereas the device taught by Zaffaroni is used to deliver drugs into the uterus as it disintegrates and is intended not to be "felt" by the user.

Regarding the limitations set forth in claims 9 and 14, both are not simply limitations that are "purely functional in nature and do not recite any structure." To the contrary, claim 9 claims, in part, that the device has a mass balanced evenly about the fulcrum and claim 14 claims, in part, that the distance from the first rounded end to the second rounded end is 3.4 inches. Accordingly, both claims 9 and 14 further describe the structural characteristics of the claimed invention in order to achieve the claimed result of exercising the Kegel muscle of a female with

an S-shape intermediate portion connecting the first rounded end to the second rounded end so that the ends and the intermediate portion lie in a plane and are spaced from each other such that the second rounded end may be inserted into the anal cavity after the first rounded end has been inserted into the vaginal cavity and the fulcrum of the S-shaped intermediate portion bears against the front and back walls of the Kegel muscle. In other words, both claims 9 and 14 further structurally define the claimed device in order for the fulcrum of the S-shaped intermediate portion to bear against the front and back wall of the Kegel muscle.

In order for Zaffaroni to anticipate the claimed invention under 35 U.S.C. § 102(b), Zaffaroni would need to teach each and every limitation of the claimed invention, which it clearly does not. Accordingly, the applicant respectfully asserts that the claimed invention of the present application is patentable over Zaffaroni and the applicant requests the Examiner to reconsider and withdraw her rejections. Claims 2-3, 9-10 and 14 depend on independent claim 1 of the present application.

The Examiner has also rejected claims 1-3, 9-10 and 15 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication no. 2003/0104909 ("Teran"). The applicant respectfully traverses the Examiner's rejection. Teran teaches an exercise apparatus adapted to be hung from a doorway (see Fig. 9) and has nothing to do with exercising the Kegel muscle. To achieve this result, the Teran device cannot be planar, as required by independent claim 1 of the present application. Furthermore, Teran does not teach an S-shaped intermediate portion connecting the first rounded end to the second rounded end such that the ends and the intermediate portion lie in a plane and are spaced from each other such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity and the fulcrum of the S-shaped intermediate portion for bearing against the front

and back walls of the Kegel muscle, as claimed in independent claim 1. In fact, Teran does not even teach a device capable of being inserted into the vaginal and anal cavities of a female for exercising the Kegel muscle. Figure 2 of Teran, upon which the Examiner relies, is actually a side view of the Teran device and it does not show the first and second rounded ends being planar, as required by independent claim 1 of the present application. Further, while Teran's exercise device may have ends with circular cross-sections, it does not teach rounded ends, as required by independent claim 1 of the present application. The applicant has addressed the Examiner's rejections of claims 9 and 14 as being solely functional above.

In order for Teran to anticipate the claimed invention under 35 U.S.C. § 102(a), Teran would need to teach each and every limitation of the claimed invention, which it clearly does not. Accordingly, the applicant respectfully asserts that the claimed invention of the present application is patentable over Teran and the applicant requests the Examiner to reconsider and withdraw her rejections. Claims 2-3, 9-10 and 15 depend on independent claim 1 of the present application.

The Examiner has also rejected claims 17 and 18 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent no. 21,189 ("Elmer"). The applicant respectfully traverses the Examiner's rejection. Contrary to the Examiner's interpretation, Elmer does not teach a method of exercising the Kegel muscle by inserting a first rounded end into the vaginal cavity, inserting the second rounded end into the anal cavity such that the intermediate portion bears against the front and back wall of the Kegel muscle, and then contracting the sphincter muscle to draw the second rounded end further into the anal cavity to press the first rounded end against the pubic bone. Rather, Elmer teaches a device for insertion solely into the vagina to support the uterus in

case of the uterus' displacement. It does not teach a method of exercising the Kegel muscle, nor does it even teach inserting any rounded end into the vagina and the other into the anal cavity.

In order for Elmer to anticipate the claimed invention under 35 U.S.C. § 102(a), Elmer would need to teach each and every limitation of the claimed invention, which it clearly does not. Accordingly, the applicant respectfully asserts that the claimed invention of the present application is patentable over Elmer and the applicant requests the Examiner to reconsider and withdraw her rejections. Claim 18 depends on allowable independent claim 17 of the present application.

The Examiner has also rejected claims 4-8, 10-12 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Zaffaroni in view of Elmer. The applicant respectfully traverses the Examiner's rejection. As set forth above, neither Elmer or Zaffaroni, either alone or in combination, teach first and second rounded ends connected by an S-shaped intermediate such that the intermediate and rounded ends lie in a plane and are spaced so that the second end may be inserted into the anal cavity once the first end is inserted into the vaginal cavity and where the fulcrum of the S-shaped intermediate bears against the front and back walls of the Kegel muscle, as required, in one form or another, in independent claims 1 and 16 of the present application.

Further, contrary to the Examiner's interpretation, the rounded ends and spherically shaped ends claimed in the present application serve mechanical functions in that the first rounded end presses upon the Graphenburg spot during use, thus providing comfortable sexual stimulation and an incentive to use the device, while the second rounded end prevents the second end from slipping out of the anal cavity while also providing a bearing surface while contracting the sphincter muscle in order to draw the second end further into the anal cavity during the exercise movement. The applicant has set forth the advantages of using the claimed rounded and

spherical shapes of the ends of the claimed device, as well as the preferred sizes thereof, in paragraph 26 of the as-filed application.

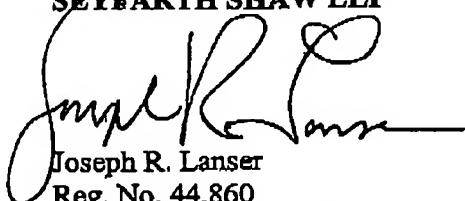
Accordingly, the applicant respectfully asserts that the claimed invention of the present application is patentable over Elmer and Zaffaroni, either alone or in combination, and the applicant requests the Examiner to reconsider and withdraw her rejections. Claims 4-8 and 10-12 dependent on allowable independent claim 1.

CONCLUSION

In view of the foregoing, and in summary, the applicant respectfully asserts that the claims, as herein presented, are patentable. Therefore, immediate allowance of the claims is respectfully requested.

Respectfully Submitted,

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